

REMARKS

Claims 1-32 in this application are pending. Claims 1-22 were allowed; claims 23-27 and 29-32 were rejected; and claims 23, 24 and 32 have since been amended. Reconsideration of the rejections is respectfully requested.

Claim rejections -- 35 U.S.C. § 102

The examiner has rejected Claims 23 and 32 under 35 U.S.C. § 102(b) as being anticipated by Loeb et al. Applicant has amended these claims. As amended, this rejection is respectfully traversed.

Applicant has amended Claims 23 and 32 to specify that the electronic device is implanted in the body in the vicinity of the joined stumps of the peripheral nerve. This location is not taught by Loeb et al. A rejection for anticipation cannot stand when, as here, a limitation in the claim is not taught by the prior art upon which the Examiner relies. See, e.g., M.P.E.P. 2131.

Claim Rejections - 35 U.S.C. § 103

The examiner has rejected Claims 24-27 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Loeb et al.

Applicant has amended Claim 24 upon which Claims 25-27 depend. As amended, the rejection of Claims 24-27 is respectfully traversed.

Applicant has amended independent Claim 24 to specify that the pulses are applied in the vicinity of the joined stumps of the peripheral nerve. Applying pulses at this location is not taught by Loeb et al. – the sole prior art relied upon by the Examiner for this rejection. A rejection for obviousness cannot stand when, as here, a limitation in the claim is not taught by the prior art upon which the Examiner relies. See, e.g., M.P.E.P. 2143. Claims 25-27 are dependent upon claim 24 and thus are also not obvious in view of Loeb et al. for the same reason.

The rejection of Claim 29 is also respectfully traversed. Independent Claim 29 specifies that the simulating pulses evoke action potentials in at least one motor axon "in a proximal stump" (emphasis added). Evoking an action potential at such a location is not taught in Loeb et al. – the sole prior art relied upon by the Examiner. Indeed, not even the Examiner contends otherwise. A rejection for obviousness cannot stand when, as here, a limitation in the claim is not taught by the prior art upon which the Examiner relies. See, e.g., M.P.E.P. 2143.

The rejection of claims 30 and 31 is also respectfully traversed. Claim 30 requires a method for treatment of injuries to peripheral nerves to augment recovery from muscle denervation which involves the application of "a non-pulsatile electric field" (emphasis added) by an implanted device. Not even the Examiner claims that Loeb et al. – the sole prior art relied upon by the Examiner -- teaches the use of non-pulsatile electric fields. (The Examiner states that "one of ordinary skill in the art would have found it obvious to apply pulses after effecting nerve repair . . ." (emphasis added)). Again, a rejection for obviousness cannot stand when, as here, a limitation in the claim is not taught by the prior art upon which the Examiner relies. See, e.g., M.P.E.P. 2143. Claim 31 is dependent upon Claim 30 and, for the same reason, is also therefore seen as allowable.

CONCLUSION

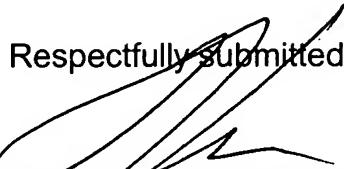
For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance and early notice of the same is earnestly requested.

Should the Examiner have any questions or further concerns regarding this application, applicant would ask that the Examiner contact Applicant's attorney, Marc E. Brown, at (310) 788-1569 to schedule an interview before issuing the next office action.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 501946,

please credit any excess fees to such deposit account and please reference attorney docket number 64693-019-6806.

Respectfully submitted,



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